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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/925,650

08/10/2001

Travis J. Parry

10012446-1

4432

7590 05/01/2009
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GARCIA, GABRIEL I

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

05/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TRAVIS J. PARRY

Appeal 2009-0509
Application 09/925,650
Technology Center 2600

Decided:¹ May 1, 2009

Before MAHSHID D. SAADAT, ROBERT E. NAPPI, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 26. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's rejection of these claims.

INVENTION

The invention is directed towards a printing method where a printer can acquire and print documents from a network address. *See* Spec. 2-5.

Claim 1 is representative of the invention and reproduced below:

1. A printing method, comprising:
 - receiving print stream data adapted to contain a network address, at a printer;
 - determining, at the printer, whether a URL or external network option is enabled;
 - detecting at the printer if a network address is in the received data;
 - sending on the Internet or other network, an access request from the printer to an administrative control entity separate and distinct from a user entity instigating the print stream data, for a document to the network address;
 - retrieving the document from the network address at the printer in the instance the administrative control entity grants the access request;
 - merging, at the printer, the document from the network address into the print stream data to form a modified document;
 - and
 - printing the modified document.

REFERENCES

Wolff	US 5,848,413	Dec. 8, 1998
Russell	US 6,375,078 B1	Apr. 23, 2002 (filed Jan. 13, 1999)

Tabata

US 6,537,324 B1

Mar. 25, 2003
(filed Feb. 13, 1998)

REJECTIONS AT ISSUE

The Examiner rejected claims 1-10, 17, 18, and 22-26 under 35 U.S.C. § 102(e) as being anticipated by Tabata. Ans. 3-5.

The Examiner rejected claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Russell. Ans. 5-6.

The Examiner rejected claims 15, 16, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Wolff. Ans. 6-7.

ISSUE

Rejection of claims 1-10, 17, 18, and 22-26 under 35 U.S.C. § 102(e) as being anticipated by Tabata

Appellant argues on pages 5 through 11 of the Appeal Brief and pages 2 through 6 of the Reply Brief that the Examiner's rejection of claim 1 is in error. Appellant argues that Tabata does not teach merging a document at the printer with print stream data to form a modified document. App. Br. 8.

Thus, with respect to claim 1,² Appellant's contention presents us with the issue: has Appellant shown that the Examiner erred in finding

² Appellant's statements on pages 11-13 of the Appeal Brief and pages 6-9 of the Reply Brief directed to claims 2-10, 17, 18, and 22-26 merely identify that these claims are allowable for the reasons that claim 1 is allowable. These statements do not amount to separate arguments under 37 CFR § 41.37(c)(1)(vii). Accordingly, claims 2-10, 17, 18, and 22-26 are grouped with claim 1.

Tabata teaches merging, at the printer, the document from the network address into the print stream data to form a modified document?

Rejection of claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Russell

Appellant argues on page 8 of the Appeal Brief and page 9 of the Reply Brief that the Examiner's rejection of claims 11-14 is in error. Appellant's arguments assert the same errors asserted with respect to claim 1.

Thus, with respect to claims 11-14, Appellant's contentions present us with the same issue as claim 1.

Rejection of claims 15, 16, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Wolff

Appellant argues on page 8 of the Appeal Brief and page 9 of the Reply Brief that the Examiner's rejection of claims 15, 16, 19, 20, and 21 is in error. Appellant's arguments assert the same errors asserted with respect to claim 1.

Thus, with respect to claims 15, 16, and 19-21, Appellant's contentions present us with the same issue as claim 1.

FINDINGS OF FACT

1. Tabata teaches a document information management system that contains a file server and a Paper User Interaction (PUI) station

apparatus that includes: a scanner, network terminal equipment, and a printer integrated into one apparatus. Abstract, col. 27, ll. 9-25 and 31-33, and Fig. 24.

2. The scanner reads image data from a medium form. Col. 27, ll. 12-14 and Fig. 24.
3. The network terminal equipment receives image data from the scanner, uses the linkage information and selection information in the image data to identify an address of the selected correlated information, and retrieves, from a file server the appropriate correlated information. Col. 27, ll. 16-20 and Fig. 24.
4. The printer prints the retrieved correlated information file, which includes the medium form information, on recording paper. Col. 26, ll. 44-46, col. 27, ll. 20-23, and Fig. 24.

PRINCIPLES OF LAW

Office personnel must rely on Appellant's disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). "[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (internal quotation marks and citations omitted; emphasis in original).

It is well settled that in order for the Examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

ANALYSIS

Rejection of claims 1-10, 17, 18, and 22-26 under 35 U.S.C. § 102(e) as being anticipated by Tabata

Appellant's arguments have not persuaded us that the Examiner erred in rejecting claim 1. Claim 1 recites "detecting at the printer if a network address is in the received data; [and]...merging, at the printer, the document from the network address into the print stream data to form a modified document." Neither Appellant's Specification nor Appellant's arguments provide a definition of the term "print stream data." Thus, we consider the scope of the claim term "print stream data" to include any information that is sent to the printer to subsequently be printed. This interpretation is consistent with Appellant's Specification since Appellant equates the data applied to the input/output circuitry with print stream data and data comprising an email or an email attachment, or data that is scanned into the printer system. Spec. 7, ¶ [0033].

Appellant first argues that Tabata does not teach that an address is detected at a printer or detected within the print stream data. App. Br. 10.

However, Tabata teaches a document information management system that contains a file server and a Paper User Interaction (PUI) station apparatus that includes: a scanner, network terminal equipment, and a printer integrated into one apparatus. FF 1. The scanner reads image data from a medium form and sends the data to the network terminal equipment. FF 2. We consider the scanned image data to be print stream data, since the scanned image data will subsequently be printed. The network terminal equipment receives the image data and uses any linkage information and selection information in the image data to identify an address of the selected correlated information. FF 3. Therefore, since the scanner (which reads print data including image data), network terminal equipment (which determines an address), and printer are all parts of the same unit, Tabata does, in fact, teach detecting an address at a printer and within the print stream data as claimed.

In addition, Appellant argues that Tabata does not teach merging a document retrieved from a detected address with the medium form information. App. Br. 10-11. However, Tabata teaches that the network terminal equipment identifies an address and retrieves, from a file server, the appropriate correlated information. FF 3. Subsequently, the printer prints the retrieved correlated information file, which includes the medium information, on recording paper. FF 4. As a result, the medium form information and the correlated information are merged together before the document is printed. Therefore, since the correlated information file is merged with the medium form information, Tabata does teach the argued limitation. Accordingly, we sustain the Examiner's rejection of claim 1. As

a result, we also affirm the Examiner's rejection of claims 2-10, 17, 18, and 22-26 which are grouped with claim 1.

Rejection of claims 11- 14 under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Russell

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 11-14. These claims ultimately depend upon claim 1. Appellant's arguments present the same issues discussed with respect to claim 1 (App. Br. 13). Therefore, we sustain the Examiner's rejection of claims 11-14 for the reasons discussed *supra* with respect to claim 1.

Rejection of claims 15, 16, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Tabata in view of Wolff

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 15, 16, and 19-21. These claims ultimately depend upon claim 1. Appellant's arguments present the same issues discussed with respect to claim 1 (App. Br. 14). Therefore, we sustain the Examiner's rejection of claim 15, 16, and 19-21 for the reasons discussed *supra* with respect to claim 1.

CONCLUSION OF LAW

Appellant has not shown that the Examiner erred in finding that Tabata teaches merging, at the printer, the document from the network address into the print stream data to form a modified document.

SUMMARY

The Examiner's rejection of claims 1 through 26 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

ELD

HEWLETT PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 272400
FORT COLLINS, CO 80527-2400